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REMARKS

Upon entry of the present Response, claims 1-20 remain pending in the present application. Claims 1, 7, and 13 have been amended herein. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks.

As an initial matter, it is noted that claims 1, 7, and 13 have been amended to change the word "indicator" to the word "identifier" so as to be consistent with all of the claims that depend there from. In this respect, the use of the term "indicator" was an inadvertent error whereas the term "identifier" was intended.

Next, in item 5 of the Office Action, claims 1-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,327,599 B1 issued to Warmus et al. (hereafter ("Warmus")). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). For the reasons that follow, Applicants assert that Warmus fails to show or suggest each of the elements of claims 1-20. Accordingly, Applicants request that the rejection of claims 1-20 be withdrawn.

Specifically, the Office Action begins with the rejection of claim 13 which states as follows:

13. A method for creating a digital picture book template in a server, comprising the steps of:
- obtaining a number of content items in a server to be depicted in a picture book cutout in the digital picture book template;
 - defining a number of pages of the picture book cutout in the server with a number of identifier lines;
 - associating at least one of the content items with at least one of the pages; and
 - associating a set of assembly instructions with the digital picture book template.

With respect to claim 13, the Office Action states in part:

"Regarding independent claim 13, Warmus discloses:

... associating a set of assembly instructions with the digital picture book template (col. 6, lines 25-30: device interface for assembling the pages to produce finished book suggest that the device interface include assembling the instructions associated with the book template)."

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Applicants respectfully disagree. Specifically, at column 6, lines 25-40, Warmus states:

"The pages printed by the demand printing system 62 may be supplied to a finishing apparatus 66 which includes various auxiliary production devices and device interfaces for assembling the pages to produce finished books which are ready for distribution. The finishing apparatus 66 may include one or more gathering devices 70 for gathering printed pages into books, one or more inkjet printers 72 for printing additional customized information, such as addressee information, on each book, one or more label printers 74 for printing address labels and/or other control devices 76. In addition, one or more detectors 78 may be provided to sense when a defective book is produced. The control unit 52 may be responsive to the output of the detector 78 to reorder a defective book at an appropriate point in the production sequence thereof so that advantage can be taken of postal discounts, if possible."

The "device interfaces" refers to potential interfacing between equipment so that pages may be provided to such finishing devices so that finishing operations can be performed. In this respect, the finishing apparatuses described by Warmus perform predefined finishing operations and do not respond to assembly instructions included in the digital picture book template as claimed above. Stated another way, it is unlikely that finishing devices require assembly instructions as they are configured to perform predefined finishing operations based upon operator selection and configuration. Accordingly, Applicants assert that Warmus fails to show or suggest at least the element of "associating a set of assembly instructions with the digital picture book template". Therefore, Applicants respectfully request that the rejection of claim 13 be withdrawn. In addition, it is noted that claims 1 and 7 include element similar in scope with that of claim 13. Accordingly, Applicants request that the rejection of claims 1 and 7 be withdrawn. Also, Applicants request that the rejection of claims 2-6, 8-12, and 14-17 be withdrawn as depending from claims 1, 7, and 13, respectively.

In addition, claim 14 provides:

14. The method of claim 13, wherein the step of associating a set of assembly instructions with the digital picture book template further comprises the step of positioning a graphical depiction of an assembly of a picture book from the picture book cutout into the digital picture book template, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book.

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With respect to claim 14, the Office Action states:

"Regarding claim 14, which is dependent on claim 13, Warmus discloses positioning a graphical depiction of an assembly of a picture book from the picture book cutout into the digital picture book template, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book (FIG. 6ab, 7a, 8ab, 9, col. 7, lines 1-23, 36-67, col. 8, lines 5-15: the graphical depiction with the folded lines to define pages of the book cutout)." (Office Action, page 4).

Applicants respectfully disagree. Specifically, FIG. 6a-b, 7a, 8a-b, and 9 depict pages of books that may need trimming based on indicator lines. However, nowhere do these figures show or suggest positioning a graphical depiction of an assembly of a picture book from the picture book cutout itself. In addition, these figures neither show or suggest including identifier lines within the graphical depiction to aid in the assembly of the picture book so that the user may draw an association between the indicator lines depicted in the graphical depiction and the indicator lines on the picture book template itself.

In addition, at column 7, lines 1-23, 36-67, and column 8, lines 5-15, Warmus states:

"For the purpose of explaining the present invention, as a first example, it will be assumed that the demand print system 62a will be operated to produce three 4-page books in the form of a brochure in duplex format. That is, as seen in FIGS. 6a and 6b, a first sheet of paper 100 is to be printed on a first side 100a with printed pages P1, P4 while a second side 100b of the sheet 100 is to be printed with pages P2, P3. In addition, pages P1-P4 are to be imposed such that the page P1 is placed on a right-hand portion 100a-r of the side 100a while the page P4 is placed on a left-hand portion 100a-l of the side 100a. Further, the page P2 is to be placed on a left-hand portion 100b-l of the side 100b while the page P3 is to be placed on a right-hand portion 100b-r of the side 100b. In this fashion, when the sheet of paper 100 is folded along a fold line 102 with the pages P1 and P4 on the outside, the pages P1 and P4 will appear in sequence. Because each book to be produced in this example comprises only a single sheet of folded paper, the imposition process need not take into account shingling or bottling effects, although it should be noted that such effects may have to be taken into account when more than one sheet of paper is assembled with other sheets of paper to produce a book and/or when more than two pages are to be printed on a single side of a sheet of paper and thereafter assembled with other pages to create a book

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It should be noted that the present invention is not limited to production of books of the same "version" (i.e., books having the same master information). For example, the book versions of FIGS. 7a, 7b and 8a, 8b may be produced together with the book version of FIG. 6a and 6b in the same production run or job. The book version example of FIGS. 7a and 7b includes pages P5-P8 to be reproduced a number of times to produce individual books. The book version of FIGS. 7a and 7b is identical to of the book version of FIGS. 6a and 6b except that an additional area 113 is provided on the page P5 for placement of variable information, in addition to the areas 110 and 112. Because of the addition of the area 113, the remaining master information appearing in an area 114 differs from master information appearing in an area 116 of the page P1 of FIG. 6a.

The book version example of FIGS. 8a and 7a differs from the book version examples of FIGS. 6a, 6b and 7a, 7b not only in terms of content of master and variable information, but also a number of pages and page size. Specifically, eight pages P9-P16 are to be printed wherein the pages P9, P12, P13 and P16 are to be printed in a first side 117a of a sheet of paper 118 and the remaining pages P10, P11, P14 and P15 are to be printed on a second side 117b of the sheet 118. In addition, the pages P11-P14 are printed upside down relative to the remaining pages so that, when the sheet 118 is folded first along the fold line 119a and then along a fold line 119b, the resulting pages P9-P16 appear in order. Thereafter, the folded sheet 118 is trimmed to separate the pages P9-P16. As should be evident, the pages P9-P16 are one-half the size of the pages P1-P8, and further include different master and variable information thereon.

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Referring again to FIG. 5, one or more template files 106 are developed by a publisher specifying the content (including appearance) of fixed information and the positioning of all information (i.e., fixed and variable) on the different books or book versions. A database 108 is also developed by the publisher using the personal computer 54 specifying the content of variable information to be placed in variable information areas, for example, the areas 110, 112 on the pages P1, P4, respectively, of FIGS. 6a and 6b. The database 108 further includes control information, as noted in greater detail hereinafter."

Applicants assert that nowhere in the above cited excerpts, nor anywhere else does Warmus show or suggest the concept of positioning a graphical depiction of an assembly of a picture book from the picture book cutout into the digital picture book template, where the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book itself. In this respect, a user can draw an association between the identifier lines in the graphical depiction of the instructions and in the

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picture book template itself in order to aid assembly thereof. Rather, the cited excerpts of Warmus generally described various printing operations including imposition of pages and assembling of books in a mass production process. Accordingly, Applicants assert that the rejection of claim 14 is improper. In addition, Applicants assert that the rejection of claims 4 and 9 is improper as including subject matter similar in scope with that of claim 14. Accordingly, Applicants respectfully request that the rejection of claims 4, 9, and 14 be withdrawn for these additional reasons.

In addition, claim 18 includes the element of "a graphical depiction of an assembly of the picture book from the picture book cutout, wherein the identifier lines are shown in the graphical depiction to aid in the assembly of the picture book." In this respect, claim 18 recites subject matter similar in scope with that of claim 14 above. Accordingly, Applicants request the rejection of claim 18 be withdrawn for the same reasons as described above with respect to claim 14.

In addition, claim 20 recites:

20. (Original) The picture book template of claim 18, wherein a correspondence between an identifier line in the picture book cutout and an identifier line in the graphical depiction is indicated with a predefined color.

With respect to claim 20, the Office Action states:

"Regarding claim 20, which is dependent on claim 18, Warmus does not disclose a correspondence between an identifier line and the picture book cutout and an identifier line and the graphical depiction as indicated with a predefined color. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Warmus to include said correspondence since it was well known in document processing that text, line or graphic in a document can be set in a desired color for differentiating purpose. The identifier line in the picture book cutout and the identifier line in the graphical depiction, accordingly, must be set in the same desired color for easily identifying." (Office Action, page 6).

Applicants respectfully disagree. Specifically, given that Warmus fails to show a graphical depiction of an assembly of a picture book at all, how is it that Warmus would further suggest the use of color coding in the indicator lines within the graphical depiction that correspond to indicator lines in the template?

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Thus, it is apparent that the rejection of claim 20 is necessarily based upon hindsight reconstruction using the claims of the present application as a blueprint. Applicants assert that such an approach in rejecting claims is impermissible.

In addition, given that the features of claim 20 are not shown or suggested in a cited reference as admitted by the Office Action, then it is apparent that the rejection is based upon Examiner's personal knowledge. When a rejection in an application is based on facts within the personal knowledge of an Examiner, it should be as specific as possible. When called for by the Applicant, the Examiner must support the assertion with an affidavit which is subject to contradiction or explanation by the affidavits of the Applicants or other persons. 37 C.F.R. 1.104(d)(2). Accordingly, Applicants call for either the citation of appropriate references that show or suggest the elements of claim 20 or that an affidavit attesting to facts within the personal knowledge of the Examiner be provided. In the absence of either of these, Applicants request that the rejection of claim 20 be withdrawn for these additional reasons.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,


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